

REMARKS

Claims 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76-79, 83 and 84 are pending in the application. Claims 77-79, 83 and 84 are withdrawn from consideration. Claim 85 is added.

Restrictions/Elections and Clarification

The acknowledgement of Applicant's election of Group IV is noted. Claims 1, 3-5, 7-11, 14, 16-24, 27, 28, 37, 38, 40-51, 61-64, 67, 68, 76-79, 83 and 84 encompass the elected invention of Group IV. Consequent on the election of Group IV, the species of 9-phenylpropyl compounds, in particular the species of ethyl 9-phenylpropyl-1-methyl- β -carboline-3-carboxylate (i.e., compound 59, described in Example 88 on page 57 of the application and illustrated on page 55 of the application) was elected. The claims readable on the elected species of ethyl 9-phenylpropyl-1-methyl- β -carboline-3-carboxylate (i.e., compound 59) are claims 1, 3-5, 8-11, 14, 16-24, 37, 38, 40-45, 61-64, 67, 68, 76-79, 83 and 84. Claims 1, 37, 76, 77 and 84 are generic.

Examiner Desai indicated in the Office Action that she was unable to locate the species of compound 59 in Example 88 in the specification. Further, the claims readable on the elected species were rejected under 35 U.S.C. §112, second paragraph as indefinite with regard to the R₅ substituent.

In a telephone interview conducted on November 8, 2010, Applicant's undersigned representative identified compound 59 with greater specificity on pages 55 and 57 of the specification. During the interview, it was agreed that claim 1 would be amended to resolve the ambiguity regarding the formula in the original claim by presenting the formula without the R₅ substituent or charges, consistent with the elected species (compound 59; see page 55 of the application, for example). Dependant claims have been amended or canceled accordingly. The granting of this telephone interview and the opportunity to clarify the election and claim language is gratefully acknowledged.

Also, objected to withdrawn claims 77-79, 83 and 84 have been amended to proper statutory from for method of use claims.

Other claims have been amended to address clerical issues.

It is understood that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim.

It is further understood that rejoinder of non-elected claims is possible if these claims require or are amended to require all the limitations of an allowable claim. Accordingly, in accordance with MPEP 821.04(a), if any elected claim is found to be allowable Applicants respectfully request the opportunity for rejoinder of non-elected claims.

Claim Rejections under 35 U.S.C. §§102 and 103

Claims 1, 3-5, 7-11, 16-24, 38, 43-51, 61, 62 and 76 were rejected under 35 U.S.C. 102(b) as being anticipated by Moody, Christopher et al. Claims 1, 3-5, 7-11, 14, 16-24, 37, 38, 40-51, 61-64, 67, 68 and 76 were rejected under 35 U.S.C. 102(b) as being anticipated by BE 612725 (Fredrick Leonard). Claim 1 has been amended to exclude the noted species in the cited references, ethyl 9-benzyl- β -carboline-3-carboxylate and 3-aminocarbonyl-9-benzyl-1-methyl- β -carboline, respectively. Accordingly, it is respectfully submitted that the claims, as amended, are novel over the cited art and withdrawal of the rejections under 35 U.S.C 102(b) is respectfully requested.

Claims 1, 3-5, 7-11, 14, 16-24, 37, 38, 40-51, 61-64, 67, 68 and 76 were rejected under 35 103(a) as being unpatentable over BE 612725 (Fredrick Leonard) or Ishida Junko et al. or WO 97/37658 (Spinelli et al.). Claim 1 has also been amended to exclude compounds wherein the R₃ group is methoxy. As indicated in Table 34 (page 89) of the application, harmine derivatives of this type, wherein R₃ is methoxy, have been found to have considerable neurotoxicity, whereas similar compounds wherein R₃ is not methoxy, as presently claimed, have distinctly reduced neurotoxicity. The cited prior art teaches R₃ methoxy-substituted compounds, but lacks any teaching of the increased neurotoxicity associated with the R₃ methoxy-substituted compounds. One of ordinary skill in the art would not be led by this cited art to select the pharmacologically acceptable (non-neurotoxic) non-R₃ methoxy-substituted compounds, as presently claimed, from among the many compounds disclosed. Accordingly, amended claim 1 possesses unexpected technical effects and is respectfully submitted to be non-obvious for at least this reason.

The remaining rejected claims depend directly or indirectly from claim 1 and are therefore submitted to be patentable for at least the same reason.

Accordingly, withdrawal of the rejections under 35 103(a) is respectfully requested.

Dependent Claims

It is further submitted that a number of dependent claims have independent bases for patentability beyond those discussed above. As one example, new claim 85 is directed to the elected

species of compound 59, ethyl 9-phenylpropyl-1-methyl- β -carboline-3-carboxylate alone. It is respectfully submitted that this species is nowhere taught or suggested by the cited art and is patentable for this reason in addition to the reasons presented above with respect to the more general claims.

Conclusion

Applicants believe that all pending claims are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner believe that a telephone conference would expedite the prosecution of this application the undersigned can be reached at the telephone number set out below. If any additional fees are due in connection with the filing of this amendment, the Commissioner is authorized to charge such fees to Deposit Account 504480 (Order No. CPALP003).

Respectfully submitted,
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